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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,991	01/04/2002	John K. Junkers	1847	7858

7590 10/31/2003

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EXAMINER

MEISLIN, DEBRA S

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 10/31/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,991

Applicant(s)

JUNKERS ET AL.

Examiner

Debra S. Meislin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 August 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 5, the structure of the rod is not understood in view of the specification (last paragraph of page 8) and drawings. The piston area is not understood in view of the specification and drawings. The original disclosure defines one of the pistons as having a second piston rod extending to the right. Newly amended page 8 of the specification defines a housing having a rod extending to the left. Newly submitted claim 5 defines a housing having a rod slidably extending within the opposite side of the piston to assure that the pistons have the same piston area. Applicant's arguments defines a second piston rod which extends from the right of piston 8 and moves together with the piston 8 since it is firmly connected thereto, consequently providing equal piston areas for pistons 5 and 8.

Applicants arguments, the drawings, the claims, and the specification must be consistent. For the pistons (5, 8) to have equal piston areas on the right sides thereof, the rod (20) must be fixed to the piston (8) and movable therewith. However, the disclosure fails to correctly define the structure of the piston (8) and the rod (20).

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Additionally, claim 5 fails to correctly define the structure of the piston (8) and the rod (20).

Upon review of all of the conflicting recitations, it appears that the description in the last paragraph of page 8 of the specification should read as follow:

--As can be seen form the drawings, the piston 8 has a second piston rod 20 connected thereto which extends to the right. A connecting rod (which attaches the second piston rod to the piston 8) of the second piston rod 20 has the same diameter as the piston rod 9 of piston 8, to assure that both pistons 5 and 8 have the same piston areas 21 and 22 correspondingly at the right side thereof. The second piston rod 20 moves together with the piston 8 and is slidable within a rear portion of the housing.--

Appropriate correction to claim 5 must also be made which is consistent with the specification and the drawings.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons set forth in paragraph 2, above.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junkers ('865) in view of Berneuil et al.

Junkers ('865) discloses all of the claimed subject matter except for having two pistons in a single cylinder. Berneuil et al discloses having two pistons in a single cylinder. Berneuil et al further discloses a solid piston rod extending through a hollow piston rod. It would have been obvious to one having ordinary skill in the art to form the pistons/cylinders of Junkers ('865) as two pistons with a solid piston rod extending through a hollow piston rod in a single cylinder to minimize the bulk of the cylinder as taught by Berneuil et al.

6. Claim 5 may be given favorable consideration if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Applicant's arguments filed August 21, 2003 have been fully considered but they are not persuasive.

Note paragraph 2, above, regarding the rejection under 35 U.S.C. 112, first paragraph.


In response to applicant's argument that Berneuil et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or,

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if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Berneuil et al is reasonably pertinent to the particular problem with which the applicant was concerned regarding structure relating to pistons and cylinders. Specifically claimed structure relating to pistons and cylinders would lead one to search art that is specific to the structure of pistons and cylinders. Additionally, both Berneuil et al and Junkers disclose piston and cylinder actuating systems.

Berneuil et al was applied to the rejection of the claims to teach the concept of forming two pistons with a solid piston rod extending through a hollow piston rod in a single cylinder to minimize the bulk of the cylinder and not for the structure disclosed in the primary reference.

9. Any inquiry concerning this communication should be directed to Examiner Meislin at (703) 308-3671. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



D. S. Meislin
Primary Examiner
Group 3720, Art Unit 3723

October 29, 2003